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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,240	07/01/2003	Li-Xi Yang	056367-0200	3322
38706	7590	07/13/2006	EXAMINER	
FOLEY & LARDNER LLP 1530 PAGE MILL ROAD PALO ALTO, CA 94304			OWENS, AMELIA A	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,240

Applicant(s)

YANG, LI-XI

Examiner

Amelia A. Owens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8,13-15,22-24 and 57-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13,29 and 57 is/are allowed.
- 6) ☒ Claim(s) 1,8,14 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 11,12 have been canceled. Claims 1,8,13-15,22-24,57-59 are pending.
2. The indicated allowability of claims 1,8,14,22-24 is withdrawn. A rejection follows.

Claim Rejections - 35 USC § 103

3. The rejection of claims 11,12,57-59 under 35 USC 103 is dropped. Claims 11, 12 have been canceled. Claims 57-59 have been amended ^{to} depend from claim 13 creating a clear demarcation over the art.

Claim Rejections - 35 USC § 112

4. Claims 1,8,14,22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue". These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art, 6) the amount of direction provided by the inventor, 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). All of the factors have been considered but only the most relevant will be discussed below.

The nature of the invention: The nature of the invention is compounds of formula where R1 is optionally substituted, unsaturated or partially saturated, 6-membered heterocycle AND R1 is 6-membered heterocycle with one or two nitrogens in the ring; as well as compositions and method of treating colon cancer using said compound. See claims.

The state of the prior art and predictability: The state of the prior art is that it involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities (i.e. what compounds can treat which specific disease). The "predictability or lack thereof" in the art refers to the ability of one skilled in the art to

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extrapolate the disclosed or known results to the claimed invention. In the instant case with 6-membered heterocycles, one skilled in the art would expect rings containing a single oxygen, sulfur, and nitrogen atom to behave differently from one another. The skilled artisan would further expect rings with various combinations of O, S, and N atoms to behave differently. Thus, there is lack of predictability in compound art. A slight change in the structure of the compound could drastically change its biological activity in vitro. In the in vivo system, the degree of unpredictability multiplies in view of the complexity of the physiological conditions. In applications directed to inventions in arts where the results are unpredictable, the disclosure of a single species usually does not provide an adequate basis to support generic claims. In re Soll, 38USPQ 189, 191 (CCPA 1938). In the instant case, the claimed application discloses thymine-1-yl species.

Guidance and working examples: Only thymine-1-yl species have been made. Applicants have not shown compounds commensurate in scope with the claimed invention effective treating colon cancer. Applicants' assertions either that the compounds would be effective *or* that the compounds are effective are not enough. A claim cannot read on subject matter as to which the specification is not enabling. Here, the specification is not enabling for 'R1 being optionally substituted, unsaturated or partially saturated, 6-membered heterocycle AND R1 is 6-membered heterocycle with one or two nitrogens' as such term encompasses rings such as pyran, thiopyran, dioxoles, pyrazine, pyrimidine to name a few.

Since insufficient guidance and teaching have been provided by the specification, the skilled artisan, even with high level of skill, is unable to use the instant compound as claimed without undue experimentation.

5. Claims 1,8,14,22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way to convey reasonably to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The issue concerning the meaning of term - optionally substituted, unsaturated or partially saturated, 6-membered heterocycle AND R1 is 6-membered heterocycle with one or two nitrogens in the ring are discussed above.

According to the MPEP §2163 I. A. “the issue of a lack of adequate written description may arise even for an original claim when an aspect of the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that the applicant had possession of the claimed invention. The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art.” The MPEP states in §2163 II 3 ii) “The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice (see i)(A), above), reduction to drawings (see i)(B), above), or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus (see i)(C), above). See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406.” Applicants have disclosed a single thymine-1-yl species.

The Court of Appeals for the Federal Circuit held in *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398 at 1406. “[a] written description of an invention involving a chemical genus, like a description of a chemical species, “requires a precise definition, such as by structure, formula, [or] chemical name, “of the claimed subject matter sufficient to distinguish it from other materials. *In re Smythe*, 480 F.2d 1376, 1383, *Fiers*, 984 F.2d at 1171, 25 USPQ2d at 1606; *In re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 284-85 (CCPA 1973) (“In other cases, particularly but not necessarily, chemical cases, where there is unpredictability in performance of certain species or subcombinations other than those specifically enumerated, one skilled in the art may be found not to have been placed in possession of a genus. . . .”).” Applicants' functional definitions in the claimed formula simply lack the precision required by the Court of Appeals for the Federal Circuit.

According to the MPEP §2163.02 Standard for Determining Compliance With the Written Description Requirement,

“The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art

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to recognize that he or she invented what is claimed". *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter". *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983))."

Thus, one of ordinary skill in the art, who would use Applicants' compounds, would not have understood the inventor to be in possession of the claimed 'optionally substituted, unsaturated or partially saturated, 6-membered heterocycle AND R1 is 6-membered heterocycle with one or two nitrogens in the ring' at the time of filing.

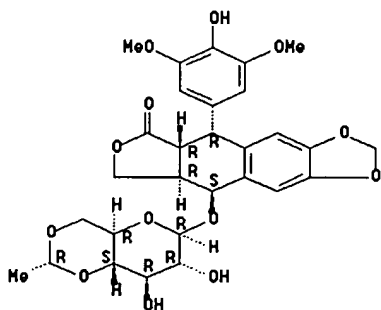
The term encompasses groups a description of which is not found in the specification.

Certain Observations

6. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 13,57-59 are allowed. The prior art neither teaches nor suggests the claimed compounds. In the absence of any evidence or apparent reason why the claimed compounds do not possess the disclosed utility, the allegation of utility in the specification must be accepted as correct. *In re Kamal et al*, 158 USPQ 320; *Ex parte Krenzer*, 199 USPQ 227.

Mantle, Therapeutic applications of medicinal plants in the treatment of breast cancer: a review of their pharmacology, efficacy and tolerability, PMID: 11059361 (2000) teach Etoposide well recognized to treat breast cancer.



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Etoposide has the above formula. One of ordinary skill in the art would expect compounds structurally to have similar properties. Thus, the claimed compounds would be expected to be useful to treat breast or colon cancer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Amelia A. Owens
Primary Examiner
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